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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,244	06/24/2003	Junichi Uji	848075/0048	5659
7590 04/27/2009 SCHULTE ROTH & ZABEL LLP 919 Third Avenue New York, NY 10022				
EXAMINER LU, ZHIYU				
ART UNIT 2618		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/603,244

Applicant(s)

UJII, JUNICHI

Examiner

ZHIYU LU

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 01/07/2009 have been fully considered but they are not persuasive.

Regarding rejection on claims 1 and 9, applicant argued that neither Ozaki nor Wolcott teach to change the portable terminal to a camera mode because Wolcott fails to expressly identify the state in which the camera is ready to take a picture or video is one such changed mode. None of the modes in Wolcott would suggest claimed invention.

However, the Examiner does not agree. The electronic camera of Wolcott is considered as a portable terminal since the claim does not specify what the portable terminal is. Despite applicant's effort in finding out the non-camera modes disclosed by Wolcott, an electronic camera must have a camera mode as its primary function and a display mode. Wolcott discloses making audible sounds when changing modes (column 11 lines 60-62), which obviously includes changing from another mode to a camera mode. So, Wolcott does teach the argued limitation.

Thus, the rejection is proper and maintained.

Regarding rejection on claim 3, applicant argued that Homma does not disclose outputting a predetermined announcement sound in response to a change to the camera mode. Homma's objective is concerned with an incoming call interfering with the taking of picture or video, not with privacy. And there is no announcement sound, only vibration in Homma.

However, the Examiner does not agree. As explained above, Wolcott already teaches outputting a predetermined announcement sound in response to a change to the camera mode. Ozaki teaches using a speaker for capture announcement. In contrast to applicant's argument, Homma does disclose making announcement via speaker for detecting incoming call (S2 of Fig. 3, column 4 lines 27-35). The combination shows the obviousness of sharing a speaker for both capture announcement and incoming-call announcement.

Thus, the rejection is proper and maintained.

Regarding rejection on claim 5, applicant argued that Chen does not direct to a portable terminal having a camera mode and a communication mode.

However, the Examiner does not agree. The claim does not having anything related to a communication mode. Though Chen's apparatus is not a camera, it is a photo monitoring apparatus. It is a component an electronic camera with an LCD equips, such as Wolcott's electronic camera. And lighting is important to photographing, which would have been obvious to one of ordinary skill in the art to incorporate the feature of Chen into Ozaki and Wolcott for low light exposure.

Thus, the rejection is proper and maintained.

Regarding rejection on claim 2, applicant argued that Ogino does not disclose a timing section for outputting the predetermined announcement sound.

However, the Examiner does not agree. In contrast to applicant's argument, Ogino does disclose timing for outputting the predetermined announcement sound (paragraphs 0010, 0012,

0026-0027), which would have been obvious for one of ordinary skill in the art to incorporate into application of Ozaki.

Thus, the rejection is proper and maintained.

2. Applicant's arguments, see REMARKS, filed 01/07/2009, with respect to the rejection(s) of claim(s) 7 and 15 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ozaki, Wolcott et al. and Miyake.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 6, 9, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki (JP10-031265) in view of Wolcott et al. (US Patent#7158945).

Regarding claim 1, Ozaki teaches an announcement method for a portable terminal (image-capturing device) comprising an image-capture section, the method comprising outputting a predetermined announcement sound when trying to take a picture (abstract, paragraph 0004). But, Ozaki does not expressly disclose changing to a camera mode.

Wolcott et al. teach a camera having different modes, wherein audible sounds are made when the user changes modes (column 11 lines 60-62, obviously as audible announcement).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate making audible announcement when changing modes taught by Wolcott et al. into the announcement method of Ozaki for mode change announcement purpose.

Regarding claim 9, Ozaki teaches a portable terminal comprising:

- an image-capturing section (3 of Fig. 1);
- a sounding body (6 of Fig. 1); and
- a control section which outputs a predetermined announcement sound from the sounding body when it has been detected that imaging-capturing section being used (paragraphs 0005-0009).

But, Ozaki does not expressly disclose the portable terminal comprising a selecting section, which selects a camera mode for using the image-capturing section and announcing when detecting the selecting section has selected the camera mode.

Wolcott et al. teach a camera having different modes, wherein audible sounds are made when the user changes modes (column 11 lines 60-62, obviously as audible announcement).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate making audible announcement when changing modes taught by Wolcott et al. into the announcement method of Ozaki for mode change announcement purpose.

Regarding claims 4 and 12, Ozaki and Wolcott et al. teach the limitations of claims 1 and 9.

Ozaki teaches wherein, in the camera mode, the output of the announcement sound is stopped while recording an image captured by the image-capturing section (paragraphs 0005-0009, wherein no announcement is made during image capturing), which is obviously interpreted as prohibiting output sound while recording an image.

Regarding claims 6 and 14, Ozaki and Wolcott et al. teach the limitations of claims 1 and 9. Ozaki teaches the control section restricts the output level of the predetermined announcement sound to a fixed output level, where obviously the output level of speaker in the portable terminal is predetermined.

4. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki (JP10-031265) in view of Wolcott et al. (US Patent#7158945) and Ogino (JP11-168646). Regarding claim 2 and 10, Ozaki and Wolcott et al. teach the limitations of claims 1 and 9. But, Ozaki and Wolcott et al. do not expressly disclose comprising a timing section which measure time, wherein the timing section outputs a signal each time a fixed period of time elapses after it was detected that the selection section has selected the camera mode, and wherein the control section causes the sounding body to output the predetermined announcement sound whenever the signal is output from the timing section. Ogino teaches a photographic device having a timing device and carrying out periodic voice generation (paragraph 0026) in voicing out camera operation, which would have been obvious to be noticed by people around.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate periodic voice generation in photographic device taught by Ogino into the modified method and device of Ozaki and Wolcott et al., in order to attract attentions of others to notice the operation of the camera in image-capture.

5. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki (JP10-031265) in view of Wolcott et al. (US Patent#7158945) and Homma et al. (US Patent#6950126).

Regarding claims 3 and 11, Ozaki and Wolcott et al. teach the limitations of claims 1 and 9.

But, Ozaki and Wolcott et al. teach the announcement sound is outputted from one of a speaker for announcing incoming-calls or an ear speaker.

Homma et al. teach a portable camera phone (abstract, Fig. 1), wherein the announcement sound is outputted from one of a speaker for announcing incoming-calls (S2 of Fig. 3, column 4 lines 27-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate using phone speaker to make announcement for a camera phone taught by Homma et al. into the announcement method of Ozaki and Wolcott et al., in order to output announcement.

6. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki (JP10-031265) in view of Wolcott et al. (US Patent#7158945) and Chen (US Patent#5530432).

Regarding claims 5 and 13, Ozaki and Wolcott et al. teach the limitations of claims 1 and 9.

But, Ozaki and Wolcott et al. do not expressly disclose the announcement sound is output only in a case where the luminance around the portable terminal is less than a predetermined brightness.

Chen teaches an alarm device output sound in a case where the luminance around it is less than a predetermined brightness (column 1 lines 6-11), which would have been obvious to one of ordinary skill in the art to recognize its utility in warning photographer low light environment as the same in warning hidden camera usage environment, hidden in the dark.

Therefore, it would have been obvious to one of ordinary skill in the art to recognize and utilize the invention of Chen into the method and portable terminal of Ozaki and Wolcott et al. for alerting people around to achieve the purpose of preventing camera from hidden operation.

7. Claims 7-8 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozaki (JP10-031265) in view of Wolcott et al. (US Patent#7158945) and Miyake (US2001/0010549).

Regarding claim 15, Ozaki and Wolcott et al. teach a portable terminal as explained in response to claim 9 above.

But, Ozaki and Wolcott et al. do not expressly disclose outputting a predetermined announcement sound when an image-capturing button has been half-pressed.

Miyake teaches having a CPU to monitor the half-pressed state of the release switch and to output audible warning due to different errors or incomplete states (paragraphs 0071, 0128, 0146-0148), which would have been obvious to one of ordinary skill in the art to incorporate the feature of giving audible warning at half-pressed state into the portable terminal of Ozaki and Wolcott et al. as preliminary warning.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the CPU of the portable terminal of Ozaki and Wolcott et al. into monitoring half-pressed state and outputting audible warning taught by Miyake, in order to trigger public warning prior to a camera shot.

Regarding claim 7, Ozaki, Wolcott et al., and Miyake teach an announcement method for an image-capturing device as explained in response to claim 15 above.

Regarding claims 8 and 16, Ozaki, Wolcott et al., and Miyake teach the limitations of claims 7 and 15.

Ozaki teaches making announcement on picture taken at control pressed (paragraphs 0007-0009). Wolcott et al. teach making audible sound when a new picture is taken (column 11 lines 60-61). Miyake teaches having a CPU to monitor the fully-pressed state of the release switch and to output audible warning (paragraphs 0080), which would have been obvious to one of ordinary skill in the art to incorporate the feature of giving audible warning at fully-pressed state into the portable terminal of Ozaki and Wolcott et al. as picture-taken announcement.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZHIYU LU whose telephone number is (571)272-2837. The examiner can normally be reached on Weekdays: 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Zhiyu Lu
Examiner
Art Unit 2618

/Z. L./
Examiner, Art Unit 2618
April 13, 2009

/Duc Nguyen/
Supervisory Patent Examiner, Art Unit 2618